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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/621,054 | 07/21/2000 | Tatsuya Suzuki | 500.36322CX1 | 5518 |

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| EXAMINER | |
|---|---|
| BORISSOV, IGOR N | |
| **ART UNIT** | **PAPER NUMBER** |
| 3639 | |

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/621,054 | SUZUKI ET AL. | |
| | Examiner | Art Unit | |
| | Igor Borissov | 3639 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *11-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *11, 13 and 14* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 8/23/2006 is acknowledged and entered. Claims 1-10 have been canceled. New claims 11-14 have been added. Claims 11-14 are currently pending in the application.

### *Examiner's statement*

Newly submitted Claims 11 and 14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A. Claims 11 and 14 drawn to a method for determining the most inexpensive procedure of treating a discarded article, classified in class 705, subclass 400.

B. Claims 12 and 13 drawn to a method of treating a discarded article, classified in class 702, subclass 82.

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention B has utility separate from that of inventions A such as rejecting or accepting a product based on gathered information. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

### *Species*

Furthermore, this application contains claims directed to the following patentably distinct species of the claimed invention: election has to be done among the following species as follows:

Species 1: Claim 12

Species 2: Claim 13

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 11, 13 and 14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheidt et al. (US 5,654,902).**

**Claim 12.** Scheidt et al. (Scheidt) teaches a method for recyclable components, comprising,

treating the discarded article on the basis of a selected treatment procedure for separating parts incapable of being treated by facilities installed in a treatment-entrusted factory which is in charge of treatment of said discarded article (C. 5, L. 12-13; C. 3, L. 54-55);

monitoring a situation in which said discarded article is being treated (C. 5, L. 26-45);

reading out, from information concerning said discarded article, alternative treatment procedures serving for a same purpose as said selected treatment procedure

and information concerning facilities required for executing said alternative treatment procedures in case it is decided that said treating situation suffers abnormality (required different treatment) (C. 3, L. 6-11, 54-55; C. 4, L. 66 – C. 5, L. 4; C. 5, L. 12-13);

selecting alternative treatment procedure capable of being carried out by facilities installed in the treatment-entrusted factory from the information concerning the facilities installed in the treatment-entrusted factory and the information concerning the facilities required for executing said alternative treatment procedures (determining, based on said information, how to treat said disassembled components, and if it is determined that said components are qualified for reuse, sending said qualified components for refurbishing, and if it is determined that said components include a high content of pure plastics or precious materials, sending (altering treatment process) said components to a dedicated recovery lines) (C. 5, L. 12-21);

treating said discarded article in accordance with said selected alternative treatment procedure (C. 5, L. 12-21).

Scheidt does not specifically teach checking the disassembled component parts whether the relevant work has been completed.

However, Scheidt does teach checking the *disassembled* component parts through a medium of a detecting means (C. 5, L. 26-45), thereby indicating the fulfillment of the particular treatment procedure.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scheidt to include that said "checking" step includes checking the disassembled component parts whether the relevant work has been completed, because it would advantageously allow to provide a dedicated quality check in more detail of each component part (Scheidt; C. 5, L. 14-15).

### *Response to Arguments*

Applicant's arguments filed 8/23/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Scheidt makes no attempt at identifying, or selecting alternative treatment procedures that can be performed In the event a particular treatment cannot be completed, it is noted that Scheidt teaches determining, based on extracted from memory information, how to treat said disassembled components, and if it is determined that said components are qualified for reuse, sending said qualified components for refurbishing, and if it is determined that said components include a high content of pure plastics or precious materials, sending (altering treatment process) said components to a dedicated recovery lines (C. 5, L. 12-21). That is, Scheidt explicitly teaches effecting an alternative treatment procedure upon determining certain condition.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
9/19/2006

IGOR N. BORISSOV
PRIMARY EXAMINER